

REMARKS

Status of the Claims

The limitation of claims 3 and 15 have been incorporated into claim 1 (claims 3, 4, 6, 15 and 16 have resultingly been cancelled). Claim 7 has been amended to correct a typographical error. Entry of the amendment is believed to reduce the number of issues for any potential Appeal Brief and does not raise new issues as these limitations were part of dependent claims previously considered by the Examiner.

Claims 1, 5, 7, 8, 10-13, 17 and 18 are still pending. It is believed that no new matter has been added.

35 U.S.C. § 112, first paragraph rejection

- (1) The applicants attach to this response, copies of the references cited with respect to the terms "average roughness R_a " and "average depth of roughness R_z ". The portion from the applicants previous response is reproduced below:

"The Examiner is correct that the terms 'average roughness R_a ' and 'average depth of roughness R_z ' are defined with reference DIN 4768.

Annexed hereto the Examiner will find copies of the following documents:

1. Hommel Tester T500 - Technical specifications, which indicates surface evaluation parameters R_a and R_z , measured according to DIN 4768 and ISO 4287 (thereby indicating that DIN 4768 corresponds to ISO 4287);
2. CARSGALS Catalog 457010 ("CRSEALS") - Shaft requirements, which refers to R_z (DIN 4768), provides an illustration and formula
3. TECHNISCHE DARSTELLUNG, UNIVERSITÄT SIEGEN, which provides drawings and formulae of both R_z and R_a (obtained over the Internet). As this is written in German, a brief translation is in order:
 - (a) "Ermittlung der Rauheitskenngrößen R_a , R_z , R_{max} mit elektrischen Tastschnittgeräten (Auszug)" - Determination of roughness R_a , R_z , R_{max} with electric test device (Abstract)
 - (b) "Bild 1: Arithmetischer Mittenrauwert R_a " - Figure 1: average roughness R_a

- (c) "Bild 2: Gemittelte Rautiefe R_z - Figure 2: average depth of roughness (average peak to valley height) R_z
- (d) "Vorlaufstrecke" - start-up length
- (e) "Nachlaufstrecke" - stop length

From these documents, the Examiner will see that the expressions 'average roughness R_a ' and 'average depth of roughness R_z ' are well-known to those skilled in the art, and their precise meaning is known from the international standard DIN 4768.

The definition of said terms is therefore well known, and the objection to the specification should be withdrawn.

While the applicants are perfectly willing to submit the above information, even in its absence, it is noted that this merely confirms what is already known by those of ordinary skill in the art, i.e. there is no new description or clarification of the applicants invention.

- (2) The applicants are unclear as to the basis for the Examiner's rejection with regard to the previous inclusion of the phrase "according to Figure 2a" as in the first action on the merits, this portion of the rejection was included as part of a written description rejection but in the final rejection, the Examiner held that it was "...still clearly non-enabling."

Regardless of which rejection was intended, there was never a figure 2a as part of the application and this typographical error was deleted. One of ordinary skill in the art would be able to figure out that the plates described in Example B were produced in the manner described in Example A with the only difference being that four different roughnesses were set as is indicated in the "Result" table on page 10 and that specimen 2a corresponds to 2a cited in the "Result" table of Example A. Given the high burden placed on the Examiner to establish lack of written description (MPEP 2163 - "There is a strong presumption that an adequate written description of the claimed invention is present when the application is filed or lack of enablement") and for establishing lack of enablement (MPEP 2164.01(a) - consideration of the *Wands* factors), the applicants hold that the claims are adequately described and enabled.

35 U.S.C. § 112, second paragraph rejection

The applicants have corrected the typographical error for claim 7. After reviewing the IFW for this application, the Examiner is correct about the errors in spelling with regard to claims 11 and 18. However, this error appears to have occurred during the facsimile process as the applicants' file copy of the amendment faxed to the Examiner on 2 February 2004 does not contain the alleged typographical errors, i.e. there was no intended amendment for these terms as they were previously presented in the second preliminary amendment of 28 February 2002.

35 U.S.C. 103(a) rejections

Claims 1, 3-13 and 15-18 were rejected as being obvious over Löhmann et al. (U.S. Patent 6,136,397 - hereafter referred to as "Löhmann").

The applicants and the Examiner appear to have a fundamental disagreement as to whether a *prima facie* case of obviousness have been made with respect to Löhmann. The applicants respectfully submit that such a case has not been made.

The ultimate determination whether an invention would have been obvious under 35 U.S.C. § 103 is a legal conclusion based on underlying findings of fact (see *In re Kotzab*, 217 F.3d 1365, 1369, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000)). As the Examiner acknowledges, the applicants' claimed invention differs from Löhmann with respect to the range of average roughness. However, the Examiner attempts to establish equivalency between the disclosure in Löhmann of "low stick and slip friction" and the applicants' teaching of average roughness. However, there is no factual basis which supports the Examiner's beliefs and suppositions about this type of equivalency.

Löhmann's later disclosure that reduction of frictional forces can be achieved by use of a low-energy plastic surface appears at best to be unrelated to the applicants' current teaching of roughness in their claimed self-adhesive device and is more likely to be viewed as a teaching away as Löhmann appears to indicate a teaching towards reducing roughness rather than introducing roughness in Löhmann's claimed device, i.e. as previously stated, use of low-energy plastic surfaces appears to direct one of ordinary skill in the art to the use of smoother surfaces.

Even if equivalency between "low stick and slip friction" and the applicants average roughness

could have been established, the applicants' broadest claim establishes a distinct limitation with regard to the range of average roughness, R_a , and there is no factual evidence that supports the proposition that this range is overlapped or would be rendered obvious given the teachings of Lühmann.

In addition, MPEP 2143.03 states that "To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art." (see also *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)). The applicants already have asserted that claim 1 is unobvious over the prior art, but this would also extend to the various limitations of the dependent claims are even further removed from the Lühmann reference, i.e. Lühmann does not teach or suggest (1) average roughness R_a is 2-20 μm (claim 3 - an even narrower range); (2) has an average depth of roughness R_z of 1-150 μm (claim 4); (3) average roughness R_a is produced together with the device by injection molding, or is produced by etching, grinding, embossing or spark erosion (claim 5); (4) the width of the area having the average roughness R_a corresponds to or exceeds the width of the adhesive strip, and has a depth of 0.5-20 mm (claim 6), etc.

With regard to the Examiner's suggestion that the various limitations are expressly or inherently disclosed, the Examiner has already outlined what has been expressly disclosed and found that several limitations were left wanting in the Lühmann reference and if it is felt that some of the limitations are inherent, it is well known that "...the inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown." *In re Spormann*, 363 F.2d 444, 448, 150 USPQ 449, 452 (CCPA 1966).

With regard to the Examiner's assertion that even if the various limitations are not expressly or inherently disclosed, that they are "...believed to be...obvious modifications to one of ordinary skill [in the art]...", there again does not appear to be any factual basis for such an assertion. It is well known that when the USPTO relies on an express or an implicit show of motivation, it must provide particular findings related to its conclusions, and the showing must be clear and particular. Broad conclusionary statements standing alone are not "evidence". see *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

With regard to the other Lühmann references cited (i.e. U.S. Patents 6,004,665 and 5,897,949), these teachings only serve to confirm that those skilled in the art had had a difficult time in achieving sufficient bond strength between an adhesive composition and a rough surface to which the composition is applied. However, it is unclear from the Lühmann references whether this problem was solved by their

the applicants. Only the applicants' claimed invention specifically directs one of ordinary skill in the art to produce the adhesive composition/device with the requisite amount of average roughness.

Lastly, the applicants' also point to the data presented in page 10 of the specification ("evidence of secondary considerations"), i.e. by properly adjusting the average roughness (R_a) and average depth of roughness (R_z) within the applicants claimed ranges, the applicants were able to reduce the tear frequency to unexpectedly low levels. None of the Lühmann references suggests what the applicants have been able to accomplish.

For these reasons, it is believed that pending claims are unobvious over the Lühmann references.

Closing

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.116 (8 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: 6 August 2004

By: Agata Gliniska
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